



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,983	07/22/2003	Armin Heckel	1/1373	4832

28518 7590 11/30/2007
MICHAEL P. MORRIS
BOEHRINGER INGELHEIM CORPORATION
900 RIDGEBURY RD
P. O. BOX 368
RIDGEFIELD, CT 06877-0368

EXAMINER

BARKER, MICHAEL P

ART UNIT	PAPER NUMBER
----------	--------------

1626

MAIL DATE	DELIVERY MODE
-----------	---------------

11/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/624,983	Applicant(s) HECKEL ET AL.	
	Examiner Michael P. Barker	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 Sept. 07, Amd. After Non-Fin.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) 1-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-19 are pending in this Application. **Claims 17-19** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions.

Response to Remarks

The terminal disclaimers filed on 24 September 2007 have been reviewed and are accepted. The terminal disclaimers have been recorded. Accordingly, the rejections under Obviousness-Type Double Patenting are hereby withdrawn.

The only remaining issue in this Application is the inclusion of the nonelected subject matter within the Claims. Applicant, in the response filed 24 September 2007, argued that the elected invention is Group I, which encompasses **Claims 1-16**, including **R³** and **R⁴** groups that are substituted or unsubstituted phenyl groups. This argument is absolutely correct. The objection made in the previous Office Action was raised to alert Applicant to remove the nonelected subject matter, namely the instances in which **R³** and **R⁴** are other than substituted or unsubstituted phenyl.

The removal of this subject matter from each of **Claims 1-16** (including the species in which **R³** and **R⁴** are other than substituted or unsubstituted phenyl) would then render **Claims 1-16** allowable and bring about rejoinder of **Claims 17-19**, which would themselves be examined on the merits. A cursory look at **Claims 17-19** yields the following conclusions:

Claim 17: "Use of" claim, rejected under 35 U.S.C. 112/101.

Claim 18: Process claim, rejected under 35 U.S.C. 112, insufficient steps.

Claim 19: Allowable if brought within the scope of **Claims 1-16**, in which **R³** and **R⁴** are limited to substituted or unsubstituted phenyl.

Conclusion

Eliminating the nonelected subject matter from **Claims 1-16**, deleting **Claims 17 and 18**, and limiting the scope of **Claim 19** to omit instances where **R³** and **R⁴** are other than substituted or unsubstituted phenyl would bring this Application into condition for allowance.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to

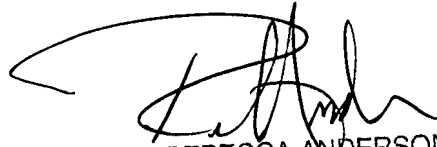
Application/Control Number:
10/624,983
Art Unit: 1626

Page 4

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.



Michael P. Barker
Patent Examiner, AU 1626
Technology Center 1600



REBECCA ANDERSON
PRIMARY EXAMINER

(for) Joseph McKane
Supervisory Patent Examiner, AU 1626
Technology Center 1600